

RESPONSE UNDER 37 C.F.R. § 1.116
U. S. Application No. 09/749,752

REMARKS

Claims 7, 8, 10, 11 and 18-21 are all the claims pending in the application.

In response to the Amendment filed March 26, 2004, the Examiner has maintained the previous claim rejections. Thus, the status of the claims is the following.

Claims 7, 8, 10, 11 and 18-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by previously-cited Zeleny et al. (US 6,215,894).

Claims 7, 8, 10, 11 and 18-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by previously-cited Noblett (US 6,362,004).

Claims 7, 8, 10, 11 and 18-21 are rejected under 35 U.S.C. § 102(b) as being anticipated by previously-cited Perttunen et al. (US 5,968,728).

Applicant respectfully traverses the claim rejections as set forth below.

In the March 26 Amendment, Applicant argued that the feature of using a marker the same as or similar to the marker used for marking the target substance, as a further modifier on the means for attaching management information peculiar to the test piece to a predetermined location on the test piece, has patentable weight. In the Response to Arguments, the Examiner asserts that the this argument is not convincing, because the specification provides that the pattern of the ID information may be attached on the test piece using a spotting device, an ink jet printer, etc. However, the Examiner's response misses the point of the argument. The fact that the specification discloses that the pattern of the ID information may be attached on the test piece using a spotting device, an ink jet printer, etc. is irrelevant to whether "using a marker the same as or similar to the marker used for marking the target substance" has patentable weight.

RESPONSE UNDER 37 C.F.R. § 1.116
U. S. Application No. 09/749,752

Since the limitation of the means for attaching is recited as a means plus function, the details of the recited function, i.e., management information peculiar to the test piece to a predetermined location on the test piece, as well as using a marker the same as or similar to the marker used for marking the target substance, do have patentable weight. These features describe the function of the means for attaching. To the extent the Examiner ignores all the recitations following the initial recitation for a “means for attaching”, this fails to give adequate consideration to functional language in the remainder of the claim.

The Examiner asserts that Zeleny discloses the claimed means for attaching of claim 8, but Applicant disagrees. We would submit that Zeleny simply discloses a printer 30 that imprints the experiment identifiers on the microchips. See col. 3, lines 26-27. Zeleny is ambiguous with respect to the feature of using a marker the same as or similar to the marker used for marking the target substance. This ambiguity cannot be used against the Applicant. Therefore, claim 8 is not anticipated by Zeleny.

Also, Zeleny does not teach or suggest the claimed means for obtaining information concerning the positions of the probes to which the target substance has bound and simultaneously detecting the management information attached to the test piece. Instead, Zeleny discloses that the bio chip passes to a scanner 42, which first scans the barcodes 16b and 18b. The system 34 responds by opening file folders 36 that are logically linked to the identifiers. In other words, the barcodes are scanned first, to open a scan protocol and upon completion of the scan protocol, an image map becomes stored. Thus, Zeleny clearly discloses that scanning of the barcodes is not performed simultaneously with the opening of the file folders. See Zeleny at col. 3, lines 30-40 and FIG. 4. Therefore, claim 8 is not anticipated by Zeleny for this reason as well.

RESPONSE UNDER 37 C.F.R. § 1.116
U. S. Application No. 09/749,752

Applicant submits that claims 7, 18 and 19 are not anticipated by Zeleny, at least because of their dependence from claim 8.

Also, claims 10, 11, 20 and 21 are not anticipated by Zeleny for reasons analogous to those for claim 8.

For the rejection of claim 8 over Noblett, Applicant submits that the reference does not teach or suggest the claimed means for obtaining information concerning the positions of the probes to which the target substance has bound and simultaneously detecting the management information attached to the test piece. Instead, the Examiner fail to describe where in the reference this feature of the claims of the present invention can be found. To the extent substances can be located in relation to a fiducial mark, the simultaneous detection of management information is not a necessary result and is thus not taught or suggested. Furthermore, the Examiner does not even assert that Noblett discloses this feature of the claims. Applicant submits that Noblett is silent regarding this feature of the claims. Hence, claim 8 is not anticipated by Noblett.

Claims 7, 18 and 19 are not anticipated by Noblett, at least because of their dependence from claim 8.

Also, claims 10, 11, 20 and 21 are not anticipated by Noblett for reasons analogous to those for claim 8.

Regarding the rejection of claims over Perttunen, Applicant has the following comments.

Applicant submits that Perttunen fails to teach or suggest the feature of claim 8 of the means for attaching management information peculiar to the test piece to a predetermined location on the test piece using a marker the same as or similar to the marker used for marking

RESPONSE UNDER 37 C.F.R. § 1.116
U. S. Application No. 09/749,752

the target substance. Perttunen is silent with respect to this feature of the claim. Instead, the reference simply discloses a data writing device 37, which writes data associated with the mapping directly to the support member 36. See col. 4, line 61 - col. 5, line 7. There is no suggestion in the reference of the data writing device of Perttunen having all of the recited features of the means for attaching management information claimed in claim 8. Thus, claim 8 is not anticipated by Perttunen.

Further, Perttunen does not disclose the claimed means for obtaining information concerning the positions of the probes to which the target substance has bound and simultaneously detecting the management information attached to the test piece. Rather, Perttunen discloses that the system of the reference includes a data base 38, which receives a signal associated with the mapping from the processor 30. The signal can include an identification code for the mapping and/or data indicative of the mapping. This disclosure of Perttunen does not correspond to the aforementioned feature of the claims. Perttunen's disclosure does not indicate when detecting of the management information is performed relative to obtaining information concerning the position of the probes. The excerpt does not relate to detecting the management information at all. Instead, Perttunen disclose that data base 38 receives a particular signal, which does not indicate detecting of the management information. Hence, claim 8 is not anticipated by Perttunen for this reason as well.

Claims 7, 18 and 19 are not anticipated by Noblett, due to their dependence from claim 8.

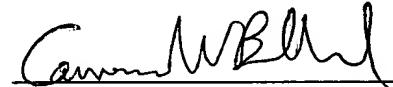
Additionally, claims 10, 11, 20 and 21 are not anticipated by Noblett for reasons analogous to those for claim 8.

RESPONSE UNDER 37 C.F.R. § 1.116
U. S. Application No. 09/749,752

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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23373
CUSTOMER NUMBER

Date: July 22, 2004